

Amendments to the Drawings

The attached sheet of drawings includes changes to Fig. 2. This sheet, which includes Figs. 1 and 2, replaces the original sheet including Figs. 1 and 2. In figure 2 omitted element numbers 42, 46, 48 and 58 have been added.

Attachment: Replacement Sheet
Annotated Sheet Showing Changes

REMARKS

I. Status of the Claims

Claims 1, 9, 15, 17 and 24 have been amended.

Claims 1-8, 10-14, 16, 18-23 and 25-29 are original.

II. The Disclosure

Applicant's invention is a novel spring clip device that is used in combination with a dog lead for use with leashes and dog runs to prevent or reduce the likelihood of injury to pets and their owners in the event that the animal suddenly runs or reaches the end of a staked position or run. The spring clip assembly includes a closable clip member pivotally connected to a housing. The spring clip further includes a sleeve member and a resilient member that biases the sleeve member within the housing. The closable clip member is adapted to be connected to the collar of the dog or other animal and is pivotally connected to the housing by use of the swivel portion. The resilient member is positioned within the housing and biases the sleeve member within the housing. The sleeve member is adapted to telescope outward from the housing and compress the resilient member in the event that a force greater than biasing force of the resilient member is applied to the device.

III. Informal Objection to Claim 15

Claim 15 was objected because the term "sleeve" lacked proper antecedent basis. Claim 15 has been amended to delete the term "sleeve" and insert the term "connection member" correcting the antecedent basis issue.

IV. Donze in View of Smith Does Not Render Claims 1-29 as Unpatentable Under 35 U.S.C. § 103

Claims 1-29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's own U.S. Patent No. 6,530,345, for a tangle-free lead device for a leash, which issued in March of 2003 in view of a one hundred year old patent to Smith et al, U.S. Patent No. 703,713 for a safety releasing device for sails, which issued in July of 1902.

In the Office Action it is stated that the applicant's '345 patent discloses the claimed combination of a spring clip device assembly comprising a clip member 16 having a closable entranceway 34 and a slidable pin 40 adapted to close the entranceway, a shaft 44 connected to the clip member. The Office Action also stated that the shaft is rotatably connected to the clip member and includes a housing 14 rotatably connected to the shaft 44, and further states that the '345 patent includes a sleeve member having a flange 22 at one end thereof rotatably mounted to the housing and adapted to be connected to a cable. In an attempt to combine references, the Office Action relies upon the Smith patent in stating that it would have been obvious to provide the housing of Donze with the resilient spring means of Smith to arrive at applicant's claimed invention. Applicant respectfully traverses the examiner's arguments.

Applicant's '345 patent discloses a tangle-free lead device for a leash that includes a clip and a sleeve, each being pivotally connected to a coupler 14, which is compared to a turnbuckle in the specification. The purpose of the lead device is to prevent the cable lead from becoming tangled. The device depicted in the '345 patent is the type of prior art which was deficient and not capable of absorbing shock forces applied to the lead when attached to an animal such as a dog and does not include a housing capable of housing a spring. Dogs are typically staked out in yards and tied to trees or other immovable objects with cable or rope to prevent them from

escaping. In the event that the dog decides to run the length of its cable, such as when it is chasing a rabbit or squirrel, the dog's neck is subjected to an extreme load force when it reaches the end of its tether, which can cause injury or death. The applicant's claimed invention, unlike the device depicted in the '345 patent, absorbs the impact force to prevent such injuries. The '345 patent does not disclose a housing or a biasing member positioned around a sleeve member within a housing to absorb the shock forces. There is no teaching, hint or suggestion for such an arrangement. That device was the starting point for applicant's improved shock absorbing clip as claimed herein.

The '713 patent to Smith is for a safety releasing device adapted to be attached to the sail of a boat and is designed to release the sail in the event that a strong gust of wind is encountered to prevent damage to the sail and injury to the crew. The springs 9, 10 are connected to the hook 13 at the first end of the cylindrical housing. The springs 9, 10 are not connected to a sleeve or similar device as required by amended claims 1, 9, 17 and 24. The springs 9,10 of Smith are adapted to allow the hook to be released to an open position when a given force is applied to the safety release device. Once the level of force is reached, the springs 9, 10 give way and allow the hook 13 to open, releasing the sail to prevent damage and injury. The '713 Smith patent actually teaches away from the applicant's invention set forth in amended claims 1, 9, 17 and 24 in that it is designed to release in the event that a load force is applied to the structure.

One would not be motivated to combine the teachings of Smith with the applicant's '345 patent to arrive at the applicant's claimed invention since the Smith device actually allows the release of the item it is attached to. Furthermore, neither Smith of the '345 patent teach a biasing member attached to a sleeve or similar member as required by amended claims 1, 9, 17 and 24. If the Smith releasing device were attached to an animal such as a dog, the dog, upon reaching

the end of its lead would cause the Smith device to open, releasing the dog from its cable and allowing the dog to escape the yard. There simply is no teaching in either the '345 patent or the '713 Smith Patent to combine these references to arrive at applicant's claimed invention. To do so would be using impermissible hindsight gained by review of applicant's disclosure. Such impermissible hindsight becomes more apparent when combined references have issue dates that span long durations of time as in this case where the '713 patent issued over one hundred years before the '345 patent. There simply is no motivation or teaching to combine these two unrelated references and to do so would produce the opposite of the intended result.

Numerous cases which have been decided by the Federal Circuit state the proposition that there must be a teaching or suggestion in the cited references to modify them as suggested by the Examiner. See, for example, Ben W. Vandenberg et al. v. Dairy Equipment Co., 224 USPQ 195 (Fed. Cir. 1984).

The issue of obviousness or non-obviousness was discussed in an opinion of the Federal Circuit entitled Orthopedic Equipment Co., Inc. v. U.S., 217 USPQ 193 (Fed. Cir. 1983). The Federal Circuit noted that the question of non-obviousness is a simple one to ask, but difficult to answer. There the Court was confronted with a situation in which the prior art showed each of the elements of the disputed claims. The question, the Court said, becomes whether it would have been obvious to a person of ordinary skill in the art to "coordinate" these elements in the same manner as the disputed claims. In cautioning against the use of hindsight in answering this question, the Court stated at page 199:

"The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references in the right way so as to achieve the result of the claims in suit.

Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law".

In In re Rijckaert, 28 USPQ2d 1955 (CAFC 1993) the Court of Appeals outlined the burden on the Patent and Trademark Office as follows:

"In rejecting claims under 35 U.S.C. \S 103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In *re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.* "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In *re Bell*, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531, (Fed. Cir. 1993) (quoting in *re Rinehart*, 531 F. 2d 1048. 1-51, 189 USPQ 143, 147, (CCPA 1976)). If the Examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. In *re Fine*, 837 F. 2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)."

There is no objective teaching in applicant's '345 patent to suggest that a housing and a sleeve may be used in combination with a biasing member to bias the sleeve within the housing . Only Applicant's specification and drawings provide that teaching.

More recently, the Federal Circuit gave additional guidance when rejecting claims as obvious over a combination of prior art references. The Court in In re Dembiczak, 50 USPQ2d 1614 (1999) reversed a rejection of claims as obvious over a combination of prior art references. The Court stated at page 1616:

"Our analysis begins in the text of section 103 quoted above, with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight," see *Loctite Corp. v. Ultraseal, Ltd.*, 781 F. 2d 861, 873, 228, USPQ 90, 98, (Fed. Cir. 1985), overruled on other grounds by *Nobelpharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059, 46 USPQ2d 1097 (Fed. Cir. 1998), when analyzing the patentability of claims pursuant to that section. Measuring a claimed invention against the standard established by section 103

requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *See e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313, (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher". *Id.*

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *See, e.g. C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232, (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine]" as an "essential evidentiary component of an obviousness holding"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("the Board must identify specifically.... the reasons one of ordinary skill in the art would have been motivated to select the references and combine them"); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783, (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]"); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion "essential" to avoid hindsight); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.* 776 F.2d 281, 297, 227 USPQ 657, 667 (Fed. Cir. 1985) (district court's conclusion of obviousness was error when it "did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination"). *See also Graham*, 3838 U.S. at 18, 148 USPQ at 467 ("strict observance" of factual predicates to obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. *See, e.g., Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."). In this case, the Board fell into the hindsight trap.

Also see Ecolochem, Inc. v. Southern California Edison Company 227 F.3d 1361 (Fed.

Cir. 2000) which held at page 1375 that:

"However, there still must be evidence that "a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed."

In re Rouffet, 149 F.3d at 1357, 47 USPQ2d at 1456; see also In re Werner Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("[A] rejection cannot be predicated on the mere identification....of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.") Here, there was no such evidence presented."

The correct view of the applicability of the '713 Smith patent as prior art is to follow its teaching. The '713 Smith patent teaches a safety releasing device for releasing ship sails in the event that the wind force applied to the sails reaches a predetermined limit to prevent damage to the sails or injury to crew members. The releasing device of the '713 Smith patent is designed to release under a sudden load and not absorb the shock caused by the load.

This teaches away from Applicant's invention, which provides a biasing member in the form of a spring to bias the sleeve within the housing. In the event that an animal, such as a dog, tries to run from its owner or reaches the end of its cable, the spring snap design is design to cushion the shock force while still retaining the dog on the lead. Such a load applied to the '713 Smith patent would permit the dog to become free from his lead and permit the dog to run freely. This is the exact opposite result that the applicant's claimed invention is trying to accomplish. It is the use of a biasing member to absorb shock forces while still retaining the animal to the lead

or cable, that is the key to Applicant's invention as set forth in amended claims 1, 9, 17 and 24. Simply citing some other reference, like Smith, that utilizes a spring within a cylindrical housing, in no way defeats the non-obviousness of Applicant's invention, other than by using Applicant's specification as a template to teach the invention.

Further, we find it improbable that one skilled in the art would reach back over one hundred years to a device that teaches away from the applicant's claimed invention by actually releasing the object to which it is attached when a load is applied thereto. To do so is a clear indication of the use of impermissible hindsight. Thus, the Examiner has failed to establish a prima facie case of obviousness within the meaning of 35 U.S.C. §103 of the subject matter of the pending claims. Rather, it appears that the Examiner has relied on impermissible hindsight in making the determination of obviousness. In re Fritch, 972F.2d, 1260, 1266, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992) ("It is impermissible to engage in hindsight reconstruction of the claimed invention using the Applicant's structure as a template and selecting elements from the references to fill the gaps").

For all of the reasons outlined above, the rejection of the claims as presently amended is unfounded since it does not properly account for and establish the obviousness of the claimed subject matter as a whole. Where the Office Action fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988).

V. Summary and Conclusion

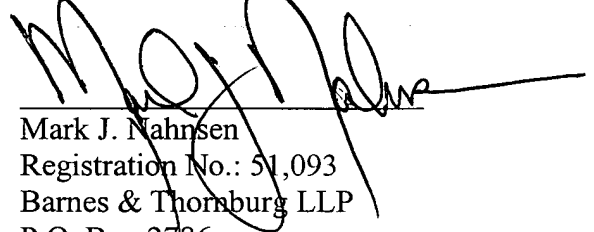
Claims 1, 9, 17 and 24 have been amended to clarify the distinctions between the claimed subject matter and the cited references. In light of the foregoing amendments and arguments, Applicants believe that claims 1-29 are allowable under 35 U.S.C. 103. Therefore, the Examiner

is respectfully requested to allow these claims to pass onward to issuance. Please contact applicant's attorney if there are other issues or to discuss expediting issuance.

No other fees are believed due at this time, however, please charge any deficiencies or credit any overpayments to deposit account 12-0913 with reference to our attorney docket number 921498-96572.

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Respectfully Submitted,



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- Amendment and Response to Office Action dated August 30, 2004
- Certificate of Mailing
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Mailed via First Class Mail on November 30, 2004.

MJN:ip

Date of deposit: November 30, 2004

I have caused that this paper is being deposited with the United States Postal Service via First Class Mail on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Iris Perez

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A handwritten signature in cursive script, appearing to read "Iris Perez", written over a horizontal line.

(Signature of person mailing paper)

41

